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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,223	03/28/2001	Terry L. McMahon	6714.01	2165

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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,223

Applicant(s)

MCMAHON ET AL.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09-21-2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

- 1) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2) Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural

Art Unit: 3629

phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art"

Art Unit: 3629

because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

Art Unit: 3629

§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the instant application, there is no significant claim recitation of the data processing system or calculating computer to show the significant change in the data or for performing calculation operations.

Claim Rejections - 35 USC § 102

3) Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Weisman et al. (US 2003/0014329).

As for Claim 1, Weisman et al. discloses a method comprising:

a) displaying one or more pre-engineered specifications for the equipment (see Figs. 1, 2-7);

b) electronically soliciting from a user a selection of one pre-engineered specification (see Supra Figs., paragraphs [0031]-[0032]);

c) soliciting from the user a selection of a manufacturer of a first component of the pre-engineered specification (see Figs. 5-12 and the descriptions thereof);

d) displaying options and prices for the first component and allowing the user to select one or more options for the same, the act of displaying options and prices including updating the displayed options and prices after an interrelated option has been selected (see *Id.*); and

e) generating a report showing the options selected for the first component and a subtotal cost for the component (see Figs. 13(I-IV)).

As for Claim 2, Weisman et al. further discloses the method including: repeating acts (c) through (e) for a second component (see Supra steps (c)-(e)).

As for Claim 3, Weisman et al. further discloses the method including: generating a report showing the components selected and the cost of the first component, the second component, and the total cost of the equipment (see Figs. 13(I-IV)).

As for Claim 4, Weisman et al. further discloses the method wherein displaying the pre-engineered specification includes displaying an approximate price for that pre-engineered specification (see Figs. 9-12 and 13(I-IV) and paragraphs [0044]-[0047]).

As for Claim 5, Weisman et al. further discloses the method, wherein displaying options and prices for the first component includes displaying those options that are available from the selected manufacturer (see Id.).

As for Claim 6, Weisman et al. further discloses the method, wherein the quote is for a lease (Inherently, every vehicle must be leased or sold to customers).

As for Claim 7, Weisman et al. further discloses the method, wherein the quote is for a purchase (see Id.).

As for Claim 8, Weisman et al. discloses a method comprising:
electronically soliciting from a user a selection for a truck class (see Figs. 1, 2-7, see paragraphs [0031]-[0032]);

Art Unit: 3629

soliciting from the user a manufacturer of a pre-engineered chassis of the truck (see Figs. 5-12 and the descriptions thereof);

displaying chassis options and prices for the chassis and allowing the user to select one or more chassis options, the act of displaying chassis options and prices including updating the displayed chassis options and prices after an interrelated chassis option has been selected (see Id.);

soliciting from the user a manufacturer of a pre-engineered body of the truck (see Supra Figs. 2-7);

displaying body options and prices for the body and allowing the user to select one or more body options, the act of displaying body options and prices including updating the displayed body options and prices after an interrelated body option has been selected (see Figs. 2-7, 9, 11-12); and

generating a report showing the chassis options selected, the body options selected, and a total cost for the truck (see Figs. 13(I-IV)).

As for Claim 9, Weisman et al. further discloses the method, wherein the chassis options include one or more of the group consisting of wheel base options, engine options, and transmissions options (see Supra Figs. 2-7).

As for Claim 10, Weisman et al. further disclose the method, wherein the chassis options include one or more of the group consisting of fuel tank options and cab options (see Id.).

Art Unit: 3629

As for Claim 11, Weisman et al. further discloses the method, wherein the body options include van body size options (see Supra Figs. 2-7).

As for Claim 12, Weisman et al. further discloses the method, wherein the body options include one or more of the group consisting of roof options, cargo control options and interior liner options (see Id.).

As for Claim 13, Weisman et al. further discloses the method, comprising displaying chassis options and prices, including displaying a subtotal price for the chassis (see Figs. 2-7 and 9, 13(I-IV)).

As for Claim 14, Weisman et al. further discloses the method, comprising displaying body options and prices, including displaying a subtotal price for the body (see Id.).

As for Claim 15, Weisman et al. discloses a method comprising:

electronically storing an at least one pre-engineered specification for a piece of equipment on a server (see Figs. 1-7);

allowing access to the stored specifications by a user (see Supra Figs. 2-7);
electronically soliciting from the user a selection of one specification stored on the server (see Id.);

displaying to the user one or more options relating to the selected specification (see Id.);

receiving from the user one or more selected options (see Supra Figs. 2-7);
updating the one or more options after each of the one or more options is selected by the user (see Figs. 1, 13(I-IV); and

displaying to the user a price quote for the selected specification and the selected options (see Id.).

As for Claim 16, Weisman et al. further discloses the method comprising displaying specifications relating to one or more manufacturers of the piece of equipment (see Figs. 2-7, 9).

As for Claim 17, Weisman et al. further discloses the method comprising displaying a link to a server wherein information from the manufacturer may be accessed (see Figs. 2-7, 9, 13(I-IV)).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,587,838 is cited to show a method and system for providing real-time notification of purchaser requirements in a network. The system includes one or more client computers interconnected to the vendor computer by the network.

US 6,339,763 is cited to show a system and method for enabling a user to select a vehicle and to overlay images of various user-selected accessories onto an image of the vehicle to cause a computer to display an image of the desired combination including a database that stores digitized images of various vehicles and accessories.

Art Unit: 3629

EP 1,139,264 is cited to show a system and method for inquiring and tracking the status of an online order for a product. The invention relates to status inquiry and reply related to orders for consumer products having specific configurations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3629
March 18, 2005



JOHN A. WEISS
SUPERVISOR
TECHNOLOGY CENTER 3629